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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,692	09/12/2003	Sakae Nakasuji	Q77449	7660

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,692

Applicant(s)

NAKASUJI ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/152,796.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4, 7, 8, and 12-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1-4, 7, 8, and 12-17 are indefinite for claiming the invention in terms of physical properties rather than the chemical or structural features that produce said properties. *Ex parte Slob*, 157 USPQ 172, states, "Claims merely setting forth physical characteristics desired in an article, and not setting forth specific composition which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future and which would impart said desired characteristics." Also, "it is necessary that the product be described with sufficient particularity that it can be identified so that one can determine what will and will not infringe." *Benger Labs, Ltd v. R.K. Laros Co.*, 135 USPQ 11, *In re Bridgeford* 149 USPQ 55, *Locklin et al. v. Switzer Bros., Inc.*, 131 USPQ 294. Furthermore, "Reciting the physical and chemical characteristics of the claimed product will not suffice where it is not certain that a sufficient number of characteristics have been recited that the claim reads only on the particular compound which applicant has invented." *Ex parte Siddiqui*, 156 USPQ 426, *Ex parte Davission et al.*, 133 USPQ 400, *Ex parte Fox*, 128 USPQ 157.

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4. Claims 12-17 are also indefinite because it is unclear how many layers and materials comprise the floor mat. Generally, the claim language is circular and confusing. Specifically, the phrase "a material other than one or more materials forming a porous material layer adjacent to the mixture layer" is unclear. Said claim is also indefinite for claiming a material in the negative (i.e., a material other than...). The metes and bounds of this negative phrase are indefinite.

5. Additionally, claims 12-17 are incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationship is: how the two or more materials of the mixture layer are combined into said mixture layer. Are said materials layered or blended? Is one material impregnated within the other material?

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 7, 8, 12, and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2001-047926 issued to Nakamura.

Nakamura teaches a floor mat for an automobile comprising a pile surface layer (31) and a sound absorbing layer (32) (abstract). The sound absorbing layer has a low density and is porous, such a urethane foam (section [0012] of translation).

With respect to claims 12 and 13, the pile surface layer is also considered porous and is a mixture of materials (i.e., pile yarns (31b) and primary backing or base cloth (31a)) different from the foam material of the adjacent porous layer.

Thus, Nakamura teaches the presently claimed invention with the exception of the claimed water resistance and permeability. However, it is reasonable to presume that these property are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e., porous layer of carpet and/or foam forming an auto floor mat). The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed water resistance and permeability would obviously have been provided by the process disclosed by Nakamura. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

9. Claims 1-5, 7-15, and 17 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6,382,350 issued to Jezewski et al.

Jezewski teaches a floor mat having a face layer and a sound absorbing backing layer (abstract). The face layer may be a carpet layer, while the sound absorbing layer may be a foam layer or a microfiber layer (col. 3, lines 22-24 and col. 4, lines 8-12). The sound absorbing layer is shown to have convex/concave profile in Figures 3 and 7. Additionally, the floor mat has a rubber base with gripping (i.e., non-slip) projections (col. 3, lines 45-60 and Figure 3).

With respect to claims 12 and 13, the face layer is also considered porous and is a mixture of materials (i.e., face yarns tufted into a primary backing) different from the material of the sound absorbing material of the adjacent porous layer (col. 3, lines 22-44). Alternatively, the sound absorbing layer may comprise a mixture of urethane resin and filler (col. 4, lines 8-34). With respect to claims 14 and 15, the carpet layer may be backed or comprise multiple sheets which would provide another porous layer (col. 3, lines 22-44). Additionally, the sound absorbing layer may comprise two or more layers (col. 4, lines 56-61). Regarding claim 17, when the sound absorbing foam resin layer is laminated or molded to the other layers, it forms a "mixture layer" comprising resin and a material of the adjoining layer in that the resin will flow to impregnate the surface of said adjoining layer.

Thus, Jezewski teaches the presently claimed invention with the exception of the claimed water resistance, permeability, and slip resistance. However, it is reasonable to presume that these properties are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e., porous layer of carpet and/or foam or microfiber forming an auto floor mat with a rubber base having projections). The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed water resistance, permeability, and slip resistance would obviously have been provided by the process disclosed by Jezewski. Note

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In re Best, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 1-5, 7-15, and 17 are rejected.

Claim Rejections - 35 USC § 103

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Jezewski reference.

Jezewski fails to teach the addition of a resin to the microfiber layer. However, it would have been obvious to one skilled in the art to add a resin to said layer as a binder for said microfibers, thereby enhancing the dimensional stability and improving the strength of said layer. Therefore, claim 6 is rejected.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Jezewski reference.

Although Jezewski does not explicitly teach the claimed thickness, the reference does state variables such as thickness are obvious to one skilled in the art. Said thickness may be varied to accommodate appropriate acoustic properties (col. 5, line 61-col. 6, line 6).

Conclusion

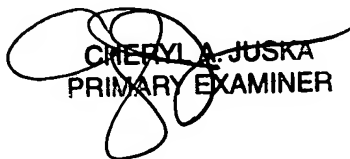
12. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER

cj
June 13, 2005